

S/N 10/032,701
Ref. No.: 659-920

REMARKS

Drawings and Specification:

In an Office Action mailed October 8, 2003, the Examiner objected to the drawings and specification. Applicants have amended the specification and resubmitted a drawing amendment to overcome the Examiner's rejections. None of these amendments has narrowed the scope of the respective claims.

Applicants note that *all* the objections relative to the drawings made by the Examiner were overcome by corrections made to the drawings filed January 9, 2004. The drawings were properly labeled as "Replacement Sheets" in the header. Rather than point out which corrections were deficient, the Examiner has merely restated her objections and refused to accept the corrected drawings. To the extent any of the previously submitted changes were not acceptable, apparently because two minor changes were inadvertently not mentioned in the Drawing Amendment, Applicants have made a further attempt here, and in the enclosed Drawing Amendment, to clarify the changes already made, but not accepted. Applicants respectfully request that, if any objections remain, the Examiner indicate with particularity such objections so that Applicants can be address them on an expedited basis. The objections, as best understood by Applicants, are as follows:

1. The Examiner has objected to Figures 17 and 18 for purportedly having extraneous text. Applicants submitted corrected drawings on January 9, 2004 that removed the text from those drawings. Applicants have resubmitted the corrected drawings for the Examiner's review.
2. The Examiner has objected to Figure 3 for not having a dashed line from reference number 145. Applicants submitted corrected drawings on January 9, 2004 that made the lead line from reference number 145 dashed. Applicants have resubmitted the corrected drawings for the Examiner's review.

3. The Examiner has objected to Figure 14 for not having a dashed line from reference number 51. Applicants submitted corrected drawings on January 9, 2004 that made the lead line from reference number 51 dashed. Applicants have resubmitted the corrected drawings for the Examiner's review.
4. The Examiner has objected to Figures 12 and 13 purportedly for not having a lead line from reference number 128 denoting the same aspect as in Figures 3-9B. Applicants note that reference number 128 refers to a "base" of an insert member, not a "surface" as referenced in the Office Action (at 2, para. 5). The lead lines for reference 128 are consistently directed to such a base in FIGS. 4-9, 12 and 13. Applicants do not understand the Examiner's objection, and ask for further clarification should a problem remain.
5. The Examiner has objected to FIGS. 15-16 for not providing a line from reference numbers 45 and 49. Applicants submitted corrected drawings on January 9, 2004 that provided separate lead lines for reference numbers 45 and 49. Applicants have resubmitted the corrected drawings for the Examiner's review.
6. The Examiner has objected to the drawings for not having dashed lines from reference numbers 14, 16, 36, 38, 74 and 72. Applicants submitted corrected drawings on January 9, 2004 that provided dashed lines for those reference numbers. Applicants have resubmitted the corrected drawings for the Examiner's review.
7. The Examiner has objected to Figure 16 for having leg elastics denoted by references numbers 36 and 38. Applicants respectfully disagree. Reference number 36 refers to waist elastics, while reference number

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38 refers to leg elastics (see Specification at 18, lines 25-30; at 27, lines 23-28).

8. The Examiner has objected to the drawings for not having a dashed line from reference number 37 in Figure 16. Applicants submitted corrected drawings on January 9, 2004 that provided a dashed line for reference number 37. Applicants have resubmitted the corrected drawings for the Examiner's review.
9. The Examiner has objected to the drawings for not having reference number 70, as set forth in the Specification at page 33, lines 30-31. Applicants submitted corrected drawings on January 9, 2004 that added reference number 70 to Figure 15. Applicants have resubmitted the corrected drawings for the Examiner's review.

The Examiner has also objected to the description with respect to the designation of "Velcro" and "lycra" without identifying those terms as trademarks. Applicants have amended the specification as set forth above to properly designate those terms as trademarks.

Claims:

The Examiner has rejected independent claims 11-20 and 31-40 as being anticipated by or made obvious over GB 2267024A to Igaue. The Examiner also has rejected claims 11-15, 17-20, 31-34, 36-40, 42 and 44 as being made anticipated or made obvious over U.S. Patent No. 6,508,797 to Pozniak, and as constituting obviousness-type double patenting with respect to Pozniak.

Rejections of Claims 11-20 and 31-40 Over Igaue:

The Examiner has rejected claims 11-20 and 31-40 over Igaue on the basis of three different arguments, namely that: (1) Igaue inherently anticipates the claimed

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subject matter, (2) Igaue makes obvious the claimed subject matter and (3) Igaue makes obvious the claimed subject matter, which are asserted to be product by process claims. Applicants respectfully disagree on all counts.

First, it is black letter law that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1944, 1957 (Fed. Cir. 1993)). “Inherency may not be established by probabilities or possibilities” (MPEP 2112, citing *In re Roberston*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

In the present case, as admitted by the Examiner, Igaue fails to disclose or teach the claimed tear and tensile strengths (Office Action at 5). In addition, however, the Examiner has failed to specify how the materials and perforations of Igaue are “identical” to those of the present application (MPEP 21112). It is clear that merely providing a perforation or line of weakness in a panel does not *necessarily* result in the panel having the claimed tear strength. Rather, the tear strength can depend on many parameters, including for example and without limitation the type of material and the configuration of the line of weakness. Indeed, Applicants’ own data showing a divergence of tear strengths depending on the perforation characteristic nullifies any argument of inherency (Specification at 15, Table I and at 37, Table II).

Second, Igaue does not suggest and in fact teaches away from the claimed tear strengths. In particular, Igaue is completely silent with respect to tear strengths across a line of weakness, but rather discloses various tensile strengths. As previously noted in Applicants’ Amendment filed January 9, 2004, Igaue does not disclose and in fact teaches away from *tensile* strengths less than about 6.62 lbf (Amendment at 14).

With respect to the claimed tear strengths, Applicants have discovered that the claimed ranges achieve unexpected results, namely that the web can be weakened to a point where a user can easily break the panel along a line of weakness. At the same

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time, the web can still be processed on a manufacturing line with minimal risk of breaking the web by virtue of using additional fasteners crossing the line of weakness or by virtue of the configuration of the manufacturing line (Specification at 8, line 14 to 9, line 12). In contrast, there is no suggestion that the claimed tear/tensile values would be desirable in the construction of Igaue, since it would be difficult to process the garment due to line breaks and the like associated with such tear/tensile values. For example, Igaue does not provide any disclosure of using fasteners across a line of weakness or weakening a line of weakness downstream in the manufacturing process.

Third, the Examiner has misconstrued the claims as being a product by process claim. The claimed tear values are *properties* of the body panel, not a process for making the panel. Accordingly, the Examiner's reliance on MPEP 2113 is totally misplaced. Moreover, the Examiner previously noted that the claims did *not* specify any testing protocol (Office Action at 4, 5). Accordingly, it is contradictory later to assert that the claims are limited by the "processing" of testing, such that the claim can be defined as product-by-process claim, all the while ignoring that testing has nothing to do with how the product is made.

For at least these reasons, Igaue does not disclose or suggest all of the limitations of claims 11-20 or 31-40 (with the same analysis applying) and the Examiner's rejections should therefore be withdrawn.

Rejections of Claims 11-20 and 31-40 Over Pozniak:

The Examiner has rejected claims 11-15, 17-20, 31-34, 36-40 42 and 44 over Pozniak on the basis of three different arguments, namely that: (1) Pozniak inherently anticipates the claimed subject matter, (2) Pozniak makes obvious the claimed subject matter and (3) Pozniak makes obvious the claims, which are asserted to be product by process claims. Since Pozniak and the present application are commonly owned, as set forth herein, Applicants have addressed only the first argument on the merits.

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In particular, as with Igaue, the Examiner has admitted that Pozniak fails to disclose or teach the claimed tear and tensile strengths (Office Action at 8). In addition, however, the Examiner has failed to specify how the materials and perforations of Pozniak are “identical” to those of the present application (MPEP 21112). It is clear, as noted above, that merely providing a perforation or line of weakness in a panel does not *necessarily* result in the panel having the claimed tear strength. Rather, the tear strength can depend on many parameters, including for example and without limitation the type of material and the configuration of the line of weakness. Indeed, Applicants own data showing a divergence of tear strengths depending on the perforation characteristic nullifies any argument of inherency (Specification at 15, Table I and at 37, Table II). Accordingly, the Examiner’s rejection based on inherency should be withdrawn.

Statement Concerning Common Ownership:

The undersigned attorney of record here states that:

The present application (S/N 10/032,701) and U.S. Patent No. 6,508,797 were, at the time of the invention of the present application (S/N 10/032,701) was made, owned by Kimberly-Clark Worldwide, Inc.

This statement alone is sufficient evidence to disqualify Pozniak from being used in a rejection under 35 USC 103 against the rejected claims (MPEP 706.02(1)(2)). As set forth in MPEP 706.02(1)(2), Applicants are not required to submit evidence such as Assignment records in addition to a statement about common ownership.

In addition, Applicants have submitted herewith a terminal disclaimer to overcome the obviousness-type double patenting rejection relative to Pozniak. This submission should not be taken as an admission that the claims are not patentably

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distinct from the claims of Pozniak. Rather, the terminal disclaimer is provided to expedite the prosecution of this application.

Amended Claims 42 and 44:

The Examiner rejected claims 42 and 44 over Pozniak. Applicants have rewritten claims 42 and 44 in independent form. Since Applicants have overcome the rejections relative to Pozniak, these claims should also be passed to allowance on the next action.

CONCLUSION:

After Amendment, this application has 22 claims, including four independent claims. Applicants previously paid for forty claims including five independent claims. Accordingly, no additional claims fee is believe to be due. If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

Dated: October 28, 2004

By:

Respectfully Submitted,



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